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EXAMINER

JOO, JOSHUA

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/990,256

Applicant(s)

CHOW, KINGSUM

Examiner

Joshua Joo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment filed 6/23/2006***

1. Claims 1-28 are presented for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 5, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) Regarding claims 4 and 5, the limitation of "successfully" renders the claims indefinite because it is unclear as to what constitutes "successfully" for the electronic mail message to be "successfully forwarded".
- ii) Regarding claim 27, the limitation of "them" is unclear because it is not clear as to what "them" is referring to in the claim. Furthermore, it is unclear as to what the limitations of "A" and "B" represent in the claim. Does "A" represent a single, specific address? Does "B" also represent a single, specific address?
- iii) Regarding claim 28, "the chain" lacks sufficient antecedent basis, and the limitation itself is not clear. Does chain represent a mapping between an old email address and a new email address?

***Response to Arguments***

4. Applicant's arguments filed 6/23/2006 have been fully considered but they are not persuasive. Applicant argued that:
5. (1) Tsuei does not teach or suggest at least the following elements of:

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wherein the electronic mail forwarding system is adapted to:  
    send a confirmation electronic mail with a required password to the user;  
    receive an electronic mail message from a sender to a recipient that  
    specifies the recipient's old electronic mail address;  
    forward the electronic mail message to the new electronic mail address, if  
    the new electronic mail address is found.

6. In response,

Tsuei teaches of:

- i) Column 9, lines 4-7, "a sender composes a message at his or her computer and addresses it to the address believed to be correct for an intended recipient. The sender then sends the message..."
- ii) Column 9, lines 54-57, "the sender ISP... sends an address query to the EAMS 330 over the Internet to determine if there is an address change registered with the EAMS."
- iii) Column 7, lines 12-19, "In response to receiving a query, the EAMS 330 can look up the e-mail address in database 338 in order to determine if the e-mail address is associated with a new e-mail address... the query to the EAMS 330 may include a message that the EAMS 330 automatically forwards ("autoforwards") to the new address if a new address is found.

Quotes (i) to (iii) of Tsuei teach of receiving an electronic mail message from a sender to a recipient, i.e. "query to the EAMS 330 may include message", that specifies the recipient's old address, i.e. "address believed to be correct for an intended recipient"; and forwarding the electronic mail message to the new electronic mail address, if the new electronic mail address is found, i.e. "automatically forwarding to the new address if a new address is found."

Tsuei does not teach of sending a confirmation electronic mail with a required password to the user. However, Polnerwo teaches of sending an electronic mail with a required password to the user (Col 1, lines 46-49).

7. (2) Tsuei does not teach or suggest at least the following elements of:

    send a confirmation electronic mail with a required password to the user;  
    receive an electronic mail message from a sender to a recipient that indicates the  
    recipient's old electronic mail address;

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if the recipient's new electronic mail message is found,  
forward the electronic mail message to the recipient's new electronic mail address;  
if the recipient's new electronic mail address is not found,  
dispatch the electronic mail message to the recipient's old electronic mail address.

8. In response,

Quotes (i) to (iii) of Tsuei teach of receiving an electronic mail message from a sender to a recipient, i.e. "query to the EAMS 330 may include message", that indicates the recipient's old address, i.e. "address believed to be correct for an intended recipient"; and if the recipient's new electronic mail message is found, forwarding the electronic mail message to the new electronic mail address, i.e. "automatically forwarding to the new address if a new address is found."

Tsuei further teaches of transmitting the electronic mail message to the recipient's old electronic mail address, and if the electronic mail message to the old electronic mail address is undeliverable, search for the recipient's new electronic mail message. However, Tsuei does not teach the method of first searching for the recipient's new electronic mail address, and if the recipient's new electronic mail address is not found, dispatch the electronic mail message to the recipient's old electronic mail address.

McDowell teaches of forwarding the electronic mail message to the user's old electronic mail address if the user is not registered (Col 8, lines 23-44).

McDowell does not explicitly teach of not finding the new electronic mail address. However, it would have been obvious to one of ordinary skill in the art that the new electronic mail address would not be found if the new electronic mail address is not registered with the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, and McDowell because the teachings of McDowell to forward electronic mail message to the user's old electronic mail

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address if a forwarding address is not found would improve the system of Tsuei and Polnerow by allowing users to receive email messages even if users are not registered users of the service.

Furthermore, since Tsuei teaches the concept of transmitting the electronic mail to the recipient's old electronic mail address, it would have been obvious to one of ordinary skill in the art to first determine if the recipient's new address is registered with the forwarding database, and if not found, then dispatch the electronic mail message to the recipient's old address because doing so would decrease the messages transmitted and the delays associated with sending and returning electronic mail messages between the sender ISP and the recipient ISP of Tsuei's system.

Tsuei does not teach of sending a confirmation electronic mail with a required password to the user. However, Polnerwo teaches of sending an electronic mail with a required password to the user (Col 1, lines 46-49).

9. (3) Tsuei or McDowell does not teach or suggest that a password is needed. Therefore, Applicant's feels that the combination of Polnerow of sending an electronic mail with a required password to the user is improper.

10. In response,

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, Tsuei addresses security concerns by requiring authentication information from subscribers for address changes (Col 6, lines 55-65; Col 10, lines 54-60). Furthermore, Tsuei teaches that there are presently several known method for authenticating a person's identity and authority (Col 10, line 66-Col 11, line 5). Polnerwo teaches of sending an electronic mail with a required password to the user (Col 1, lines 46-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, and Polnerwo because the teachings of Polnerwo to sent an electronic mail with a required password would additionally strength the authentication process of Tsuei's system by notifying the user of the registration for address forwarding and providing authentication information that would allow users to login to the service (Col 1, lines 49-51).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, US Patent #6,654,779, in view of Polnerow et al, US Patent #5,813,006 (Polnerow hereinafter).

13. As per claim 1, Tsuei teaches substantially the invention as claimed including an electronic mail forwarding system, Tsuei's teachings comprising:

a forwarding server, within a data communication network, to host forwarding searches and to perform forwarding actions (Col 6, lines 17-24. E-mail Address Management System

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(EAMS) comprising server and database correlates old email address to new email address.); and

a database, in communication with the forwarding server within the data communication network, the forwarding server to enter, update, and maintain source and destination electronic mail addresses in the database for forwarding (Col 6, lines 31-37. Recipient registers address with EAMS to store information regarding address change in the database. Contains old address and new address.);

wherein the electronic mail forwarding system is adapted to:

receive a registration for an electronic mail account of a user to forward emails addressed to the user's old electronic mail address to a new electronic mail address (Col 6, lines 31-37; Col 10, lines 48-54; Col 11, line 6-17. Register old and new email addresses.);

receive an electronic mail message from a sender to a recipient that specifies the recipient's old electronic mail (Col 9, lines 14-19. Receive message with old address. Col 9, lines 4-9. Sender sends message addressed to old address.);

search for the recipient's new electronic mail address for forwarding (Col 9, lines 60-64. EAMS searches database for record relating to a new address.); and

forwarding the electronic mail message to the new electronic mail address, if the new electronic mail address is found (Col 7, lines 15-19. EAMS forwards message to the new address.).

14. Tsuei teaches substantially the invention as claimed. However, Tsuei does not teach of sending a confirmation electronic mail with a required password to the user after registration with the server.



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15. Polnerwo teaches of registering to use a service, wherein an electronic mail with a required password is sent to the user (Col 1, lines 46-49).

16. Tsuei addresses security concerns by requiring authentication information from subscribers for address changes (Col 6, lines 55-65; Col 10, lines 54-60). Furthermore, Tsuei teaches that there are presently several known method for authenticating a person's identity and authority (Col 10, line 66-Col 11, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Polnerwo because the teachings of Polnerwo to sent an electronic mail with a required password would improve the system of Tsuei's system by informing the user of the registration and providing authentication information that would allow users to login to the service (Col 1, lines 49-51).

17. As per claim 2, Tsuei teaches the system of claim 1, wherein the data communication network includes at least one of the Internet and an Intranet (Col 4, lines 36-37. Electronic mail operates in an Internet environment. Col 1, lines 46-54. Electronic mail may involve domains such as .gov, .mil, or .edu).

18. Claims 3, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei and Polnerow, in view of Quine, US Patent #6,957,248 (Quine hereinafter).

19. As per claim 3, Tsuei does not teach the system of claim 1, wherein the user's electronic email address is disabled after the user registration.

20. Quine teaches the concept of closing an email account (Col 4, lines 45-60; Col 7, lines 54-67).

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21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, and Quine because the teachings of Quine to close an email account would improve the system of Tsuei and Polnerow by preventing additional delivery of emails into the account, and an disabled account would allow the sender to receive undeliverable messages.

22. As per claim 6, Tsuei does not teach the system of claim 1, wherein the recipient's new electronic mail address is made unavailable to the sender.

23. Quine teaches of electronic mail forwarding wherein a user's new electronic mail address is made unavailable to the sender (Col 10, lines 4-21).

24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, and Quine because the teachings of Quine to make the user's new email address unavailable to the sender would improve the system of Tsuei and Polnerow by protecting the privacy of the user and preventing the sharing of the user's new email address.

25. As per claim 9, Tsuei does not teach the system of claim 1, wherein the sender receives an electronic mail message from the electronic mail forwarding system informing the sender that the sender's electronic mail message was successfully forwarded.

26. Quine teaches of sending an email to the sender indicating that the email was properly forwarded (Col 9, lines 18-31).

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27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, and Quine because the teachings of Quine to send an email to the sender indicating that the email was properly forwarded would improve the user friendliness of the system of Tsuei, and Polnerow by providing confirmation information, thus the sender does not have to resend emails.

28. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei and Polnerow, in view of Reilly, US Patent #6,427,164 (Reilly hereinafter).

29. As per claim 4, Tsuei does not teach the system, wherein if the electronic mail message from the sender is successfully forwarded, the server to transfer an electronic mail address of the sender to the user.

30. Reilly teaches of a recipient receiving a message and the recipient being provided with the electronic mail address of the sender to reply to the sender (Col 1, lines 26-39).

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow, and Reilly because the teachings of Reilly to forward electronic mail messages and to provide the electronic mail address of the sender to the recipient would improve the system of Tsuei, McDowell, and Polnerow by providing identification information of the sender and allowing recipients to reply to the senders.

32. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, McDowell, Polnerow, and Reilly, in view of MacIntosh et al, US Publication #2002/0138581 (MacIntosh hereinafter).

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33. As per claim 5, Tsuei does not teach the system of claim 4, wherein if the electronic mail message from the sender is successfully forwarded, the user responds to one of the sender directly or to the sender indirectly through the server.

34. MacIntosh teaches that a user can respond indirectly to the sender through the server (Paragraph 0093).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Reilly, and MacIntosh because the teachings of MacIntosh to allow the user to respond indirectly through the server would enhance the system of Tsuei, McDowell, Polnerow, and Reilly by maintaining privacy of user information.

36. Claims 7, 8, 10-12, 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, in view of Polnerwo and McDowell et al, US Patent #6,438,583 (McDowell hereinafter).

37. As per claims 10, 17, and 21, Tsuei teaches substantially the invention as claimed including an electronic mail forwarding system comprising a computer readable medium and a computer readable program code stored on the computer readable medium, Tsuei's teachings comprising:

receive a registration for an electronic mail account of a user to forward emails addressed to the user's old electronic mail address to a new electronic mail address (Col 6, lines 31-37; Col 10, lines 48-54; Col 11, line 6-17. Register old and new email addresses.);

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receive an electronic mail message from a sender to a recipient that indicates the recipient's old electronic mail address (Col 9, lines 14-19. Receive message with old address. Col 9, lines 4-9. Sender sends message addressed to old address.);

search a database for the recipient's new electronic mail address for forwarding (Col 9, lines 60-64. EAMS searches database for record relating to a new address.);

if the recipient's new electronic mail address is found,

forward the electronic mail message to the recipient's new electronic mail address (Col 7, lines 15-19. EAMS forwards message to the new address. Col 10, lines 32-34. Forward message using new address.); and

make available an electronic mail address of the sender to the recipient (Col 10, lines 35-37. Message is delivered to the intended recipient. It is inherent in emailing that the sender's address is available in order for the recipient reply to the message or view the sender.);

if the recipient's new electronic mail address is not found,

send an electronic mail message to the sender indicating that the sender's electronic mail message to the recipient is undeliverable (Col 10, lines 7-11. Notifies sender the message could not be delivered.).

38. Tsuei teaches substantial features of the claimed invention including transmitting the electronic mail to the user's old electronic mail address before determining if a new electronic mail address is found in the database. However, Tsuei does not teach of sending and receiving a confirmation electronic mail with a required password to the user; and if the recipient's new electronic mail address is not found, dispatch the electronic mail message to the recipient's old address.

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39. Polnerwo teaches of registering to use a service, wherein an electronic mail with a required password is sent to the user (Col 1, lines 46-49).

40. Tsuei addresses security concerns by requiring authentication information from subscribers for address changes (Col 6, lines 55-65; Col 10, lines 54-60). Furthermore, Tsuei teaches that there are presently several known method for authenticating a person's identity and authority (Col 10, line 66-Col 11, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Polnerwo because the teachings of Polnerwo to sent an electronic mail with a required password would improve the system of Tsuei's system by informing the user of the registration and providing authentication information that would allow users to login to the service (Col 1, lines 49-51).

41. McDowell teaches of forwarding the electronic mail message to the user's old electronic mail address if the user is not registered (Col 8, lines 23-44).

42. McDowell does not explicitly teach of not finding the new electronic mail address. However, it would have been obvious that the new electronic mail address would not be found if the new electronic mail address is not registered with the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, and McDowell because the teachings of McDowell to forward electronic mail message to the user's old electronic mail address if a forwarding address is not found would improve the system of Tsuei and Polnerow by allowing users to receive email messages even if users are not registered users of the service.

Furthermore, since Tsuei teaches the concept of transmitting the electronic mail to the recipient's old electronic mail address, it would have been also obvious to one of ordinary skill in

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the art to first determine if the recipient's new address is registered with the forwarding database, and if not found, then dispatch the electronic mail message to the recipient's old address because doing so would decrease the messages transmitted and delays associated with sending and returning electronic mail messages between the sender ISP and the recipient ISP of Tsuei's system.

43. As per claim 7, Tsuei does not teach the system of claim 1, wherein the electronic mail forwarding system is further adapted to forward the electronic mail message from the sender to the user's old electronic mail address, if the new electronic mail address is not found.

44. McDowell teaches of forwarding the electronic mail message to the user's old electronic mail address if the user is not registered (Col 8, lines 23-44).

45. Motivation for combination is similar to the rejection of claim 10. See paragraph 42.

46. As per claim 8, Tsuei, McDowell, and Polnerow taught the system of claim 7. Tsuei further teaches wherein the sender receives an electronic mail message indicating that the sender's electronic mail message is undeliverable if the user's old electronic mail address is no longer reachable (Col 10, lines 7-11. Sender ISP notifies the sender via an email that the message could not be delivered to the provided address).

47. As per claim 11, Tsuei teaches the system of claim 10, wherein the instructions are provided to a forwarding server of the electronic mail forwarding system to host forwarding searches and to execute forwarding actions (Col 7, lines 9-18; Col 9, lines 59-64; Col 10, lines 28-33. EAMS searches for forwarding address and forwards message.).

48. As per claim 12, Tsuei teaches the system of claim 10, wherein the instructions are provided to enable a database to receive, update, and maintain old and new electronic mail addresses of users for forwarding (Col 6, lines 16-24. EAMS is a database system used to correlate an old email address to a new email address. Col 6, lines 31-44. User registers his/her address change with the EAMS, and the EAMS maintains a database of the old and new addresses).

49. As per claim 18, Tsuei teaches the system of claims 17, wherein the data communication network includes at least one of the Internet and an Intranet (Col 4, lines 36-37. Electronic mail operates in an internet environment. Col 1, lines 46-54. Electronic mail may involve domains such as .gov, .mil, or .edu).

50. As per claim 19, Tsuei teaches the method of 17, wherein a forwarding server, having circuitry to send and receive data to and from a database, performs forwarding searches and provides forwarding actions (Col 7, lines 9-18; Col 9, lines 59-64; Col 10, lines 28-33. EAMS searches for forwarding address and forwards electronic mail messages. Col 10, lines 48-54. Register address with the EAMS. Col 8, line 64-65. A computer system is associated with the EAMS).

51. As per claim 20, Tsuei teaches the method of claim 19, wherein the forwarding server performs the actions entering, updating, and maintaining electronic mail addresses (Col 6, lines 31-37. Recipient registers address with EAMS to store information regarding address change in the database. Contains old address and new address.).



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52. Claims 13, 16, 22, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Polnerow, McDowell, in view of Quine.

53. As per claims 13 and 22, Tsuei does not teach the invention, wherein the user's old electronic email address is disabled after the registration.

54. Quine teaches the concept of closing an email account (Col 4, lines 45-60; Col 7, lines 54-67).

55. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, Polnerow, Decuir, and Quine because the teachings of Quine to close an email account would improve the system of Tsuei, Polnerow, and McDowell by preventing additional delivery of emails into the account, and an disabled account would allow the sender to receive undeliverable messages.

56. As per claims 16 and 26, Tsuei does not teach the invention, wherein the sender is informed that the electronic mail message of the sender has been delivered to the new electronic mail address of the user.

57. Quine teaches of sending an email to the sender indicating that the email was properly forwarded (Col 9, lines 18-30).

58. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, McDowell, and Quine because the teachings of Quine to send an email to the sender indicating that the email was properly

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forwarded would improve the user friendliness of the system of Tsuei, Polnerow, and McDowell by providing confirmation information, thus the sender would not have to resend emails.

59. As per claim 24, Tsuei does not teach the system of claim 17, wherein the recipient's new electronic mail address is made unavailable to the sender.

60. Quine teaches of electronic mail forwarding wherein a user's new electronic mail address is made unavailable to the sender (Col 10, lines 4-21).

61. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, McDowell, and Quine because the teachings of Quine to make the user's new email address unavailable to the sender would improve the system of Tsuei, Polnerow, McDowell, and Quine by protecting the privacy of the user and preventing the sharing of the user's new email address.

62. Claims 14, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Polnerow, McDowell, in view of MacIntosh.

63. As per claims 14, 15, and 23, Tsuei does not teach the system, wherein the recipient has an option of responding to the sender directly to the sender's electronic mail address or responding indirectly through the forwarding server.

64. MacIntosh teaches that a user can responding indirectly to the sender through the server by providing an option to mask the user's email address so that sender does not know the user's email address (Paragraph 0009; 0093).

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65. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, Polnerow, McDowell, and MacIntosh because the teachings of MacIntosh for the user to respond to the sender indirectly through the forwarding server would improve the system of Tsuei, Polnerow, and McDowell by maintaining privacy of recipient information. Tsuei and MacIntosh do not explicitly teach of responding directly to the sender's electronic mail address. However, responding directly to the sender's electronic mail address is well known in the art, and it would have been obvious to one of ordinary skill to allow the recipient's to reply directly to the sender to provide recipient identification information to senders such as peers, friends, and families.

66. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Polnerow, McDowell, in view of Lin et al, US Patent #6,163,802 (Lin hereinafter).

67. As per claim 25, Tsuei teaches of notifying the sender that an electronic mail message was forwarded (Col 7, lines 43-46). However, Tsuei does not explicitly teach the system of claims 17, wherein the sender receives an electronic mail message from the user informing the sender that the sender's electronic mail message was forwarded.

68. Lin teaches the concept of notifying the sender of a received electronic message (Col 1, lines 42-46).

69. Lin does not teach that the user receives message that is specifically an email message, and that the user sends a response message that is also specifically an email message. Nonetheless, an email message is an electronic message, so it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lin's teachings to send an email notification for received email messages because doing so would improve the user

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friendliness the system of Tsuei, Polnerow, and McDowell by providing confirmed communication between the sender and recipient, thus allowing the sender to send future email messages using the same email address.

70. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei and McDowell, in view of MacIntosh.

71. As per claim 27, Tsuei does not teach the method of claim 17 further comprising periodically performing data clean-up of the database to detect forwarding cycles of A to B and B to A and remove them.

72. MacIntosh teaches of a user capable of managing the user's profile, wherein the user's profiled may be modified by changing and/or deleting addresses on a database (Paragraph 0086-0087; 0095-0097).

73. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, and MacIntosh because the teachings of MacIntosh to manage the user's profile by identifying and deleting forwarding addresses would improve the system of Tsuei and McDowell by allowing the user to control the addresses that may be used to forward emails. Furthermore, it would have been obvious to one of ordinary skill in the art that the user or an administrator may perform the same routine, e.g. daily or weekly, to manage forwarding addresses by deleting addresses to ensure that the forwarding addresses are up-to-date and reduce memory usage by the user's addresses.

74. As per claim 28, the method of claim 17 further comprising periodically performing data clean-up of the database to detect chaining and simplify the chain.

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75. MacIntosh teaches of identifying addresses and simplifying the chain, e.g. changing or deleting addresses, on a database (Paragraph 0086-0087; 0095-0097).

76. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei, McDowell, and MacIntosh because the teachings of MacIntosh to identify addresses and simplify the chain, e.g. changing or deleting addresses, on a database would improve the system of Tsuei and McDowell by allowing the user to control the addresses that may be used to forward emails. Furthermore, it would have been obvious to one of ordinary skill in the art that the user or an administrator may perform the same routine, e.g. daily or weekly, to simplify the chain, e.g. changing or deleting addresses, because doing so would allow the user or the administrator to ensure that the forwarding addresses are up-to-date and allows the management of addresses.

### ***Conclusion***

77. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

78. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

79. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7 to 4.

80. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on 571 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

81. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 1, 2006  
JJ



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